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In re Application of SHUSTER et al.
Application No.: 10/500,493
PCT No.: PCT/US02/41751
Int. Filing: 31 December 2002
Priority Date: 31 December 2001
Attorney Docket No.: 14848-006US1
For: METHODS AND MATERIALS FOR
MODULATING TRPC4

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: DECISION ON
:
: PETITION
:
: UNDER 37 CFR 1.47(a).
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This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 03 December 2004.

BACKGROUND

On 29 June 2004, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 05 October 2004, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 03 December 2004, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor Ulf N.G. Arvidsson.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

(1). With regard to Item (1), Petitioner submitted \$130 for the petition fee, satisfying Item

Petitioner satisfied Item (4) with the submission of the declaration executed by the joint inventors on their behalf and on behalf of the non-signing inventor Ulf N.G. Arvidsson.

However, with respect to Item (3), Petitioner has provided a statement of the last known address of the non-signing inventor.

With respect to item (2), Petitioner states that Mr. Arvidsson is unavailable to sign the declaration, providing a statement of M. Angela Parsons, technologist specialist with Fish & Richardson. Ms. Parsons states:

We diligently attempted to locate Ulf N.G. Arvidsson. We attempted to find any current contact information for Ulf N.G. Arvidsson using a number of different Search engines and Web pages on the Internet. Attempts were made to contact Ulf N.G. Arvidsson by telephone at his last known work number and home number. Our attempts to locate Ulf N.G. Arvidsson were unsuccessful.

As indicated in the MPEP Section 409.03(d), where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. *The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.* Statements based on hearsay will not normally be accepted. *Copies of documentary evidence* such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, diligent efforts made to locate Ulf N.G. Arvidsson were not pursued and documented, such as Internet searches, E-mail contact to obtain a current address, contact with his former employer or joint inventor to obtain a forwarding address or a request from the Postal Service for his forwarding address. Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a "diligent effort" was made. Petitioner's statement of facts under 37 CFR 1.47(a) merely states that a search for Ulf N.G. Arvidsson was unsuccessful. Since no attempts to locate inventor Ulf N.G. Arvidsson have been documented, it can not be concluded that "a diligent effort" was made to locate the non-signing inventor.

The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. Under these circumstances, it cannot be concluded that Ulf N.G. Arvidsson is unavailable to sign the application. Petitioner has not demonstrated that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/500,493 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and (2) Ulf N.G. Arvidsson's unavailability after petitioner's diligent effort or Ulf N.G. Arvidsson's refusal to sign, either in writing or orally, these documents. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed

within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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